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SMITHKLINE BEECHAM CORPORATION
Corporate Intellectual Property - UW2220
P.O. Box 1539
King of Prussia, PA 19406-0939

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OFFICE OF PETITIONS

ON PETITION

In re Application of
Campbell, et al.
Application No. 09/735,438
Filed: December 13, 2000
Attorney Docket No.: P31376-C1
For: ACTIVITY OF PENCICLOVIR
AGAINST EPSTEIN-BARR VIRUS

This is a decision on the "RESPONSE TO NOTICE TO FILE CORRECTED APPLICATION PAPERS," filed September 30, 2002. This response is being treated under 37 CFR 1.137(a) as a petition to revive the above-identified application and in the alternative under 37 CFR 1.137(b).

The petition under 37 CFR 1.137(a) is **DISMISSED**.

The petition under 37 CFR 1.137(b) is **GRANTED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." This is not a final agency decision.

This application became abandoned April 14, 2001 for failure to timely file a proper response to the Notice to File Corrected Application Papers ("Notice") mailed February 13, 2001. The Notice set a shortened two (2) month statutory period for reply. No extensions of time in accordance with 37 CFR 1.136(a) were obtained. This decision precedes Notice of Abandonment.

DECISION UNDER 37 CFR 1.137(a)

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

The present petition does not satisfy requirement (3) above.

The Office may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable." See, 37 CFR 1.137(a)(3). Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). A petition to revive an application as unavoidably abandoned cannot be granted where petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

Petitioner states the application was originally owned by SmithKline Beecham Corporation and that the application was assigned to Novartis Pharmaceuticals Ltd. Petitioner states a power of attorney and change of address were submitted January 18, 2002. Petitioner attributes the delay in responding to the Notice to the fact that Novartis Pharmaceuticals Ltd. did not receive a copy of the Notice until September 26, 2002.

Where an application becomes abandoned as a consequence of a change of correspondence address, an adequate showing of "unavoidable" delay requires a showing that due care was taken to adhere to the requirement for prompt notification of the change of address and must include an adequate showing that a timely notification of the change of address was filed in the application concerned in a manner reasonably calculated to call attention to the fact that it was a notification of change of address. See, MPEP 711.03(c).

As of the mail date of the Notice on February 13, 2001, the correspondence address of record was that of SmithKline Beecham Corporation. The power of attorney and change of correspondence address referenced by petitioner was not received by the Office until January 18, 2002. Accordingly, there is a strong presumption that the Notice was properly mailed to applicant at

the correspondence address of record. Applicant's failure to promptly submit a change of correspondence address does not constitute unavoidable delay within the meaning of 37 CFR 1.137(a).

The required petition fee of \$110.00 has been charged to Deposit Account No. 19-0134 as authorized in the instant petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, DC 20231

By facsimile: (703) 308-6916

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA 22202

DECISION UNDER 37 CFR 1.137(b)

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

As to item (2), the required petition fee of \$1,280.00 has been charged to Deposit Account No. 19-0134 as authorized in the instant petition.

The instant petition has been reviewed and found in compliance with the requirements of 37 CFR 1.137(b). Accordingly, the petition for revival is hereby **GRANTED**.

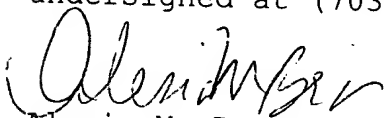
As to the power of attorney/change of correspondence address submitted January 18, 2002, the requested changes have not been entered into the record. While the Office acknowledges the recordation of assignment from SmithKline Beecham Corporation to Novartis Pharmaceuticals Corporation, there is no indication in Office assignment records that applicants have assigned their

interest in the application to SmithKline Beecham Corporation or any other corporate entity. Accordingly, petitioner is required to correct the change of title before the requested power of attorney/change of correspondence address will be entered. If petitioner is aware of a recordation of assignment from the inventors of record to SmithKline Beecham Corporation, petitioner should provide the reel/frame reference upon renewed petition.

Petitioner is reminded that the Office does not engage in dual correspondence. If petitioner desires to receive future correspondence regarding this patent application, including future Office actions, the appropriate documentation, as referenced above, must be submitted. **Petitioner is advised that all future correspondence will be directed to the correspondence address currently of record until such time as appropriate instructions are received to the contrary.**

This application is being forwarded to the Office of Initial Patent Examination for further processing.

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 305-0310.



Alesia M. Brown
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

CC: THOMAS SAVITSKY
NOVARTIS PHARMACEUTICALS
PATENT AND TRADEMARK DEPT.
564 MORRIS AVENUE
SUMMIT, NJ 07901-1027